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10/537,921

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John Window

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EXAMINER

HOLLOWAY, JASON R

ART UNIT

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3633

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/537,921

Applicant(s)

WINDOW, JOHN

Examiner

JASON HOLLOWAY

Art Unit

3633

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2006.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
4a) Of the above claim(s) 5-21 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-4 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☒ Claim(s) 1-21 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 03 June 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-85/86)
Paper No(s)/Mail Date 11-10-08
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Inventor's Patent Application
6) ☐ Other: _____

DETAILED ACTION

This communication is a first Office Action Non-Final rejection on the merits.

Claims 1-17, as originally filed, are currently pending and have been considered below.

Claim 9 is withdrawn from consideration as being drawn toward a non-elected species.

Election/Restrictions

1. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

Species 1; figure 16, directed toward a spur member with a C-channel with a t-shaped plan view outline.

Species 2; figure 17, directed toward a spur member C-channel with a top hat section.

Species 3-16; figures 18a-18n directed toward alternative C-section configurations for upright members.

Species 17; figure 21, directed toward a vertical column for use in the erection of tall buildings.

Species 18; figure 22, directed toward an alternative design of a vertical column.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims

subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The following claim(s) are generic: 1.

2. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: The various embodiments of uprights and spur members constitute different inventions.

3. During a telephone conversation with Mr. Alan Towner on 4 November 2008 a provisional election was made without traverse to prosecute the invention of species 1 figure 16; species 3, figure 18a; and species 17, figure 21. Claim 9 is withdrawn from further consideration as being drawn to a non-elected species. Affirmation of this election must be made by applicant in replying to this Office action.

Drawings

4. The drawings are objected to because figure 19 is missing from the drawing set. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an

amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. The disclosure is objected to because of the following informalities: Reference to specific claims in the specification is not permitted.

Appropriate correction is required.

Claim Objections

6. Claims 5-8, and 10-17 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot be dependent upon another multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the recitation "the cross-braces of each wall lattice framework are centered on a plane that is displaced outwardly from the internal dimensions of the shell" renders the claim indefinite because it is unclear what plane is being referred and where the center of the plane is.

Claims 2-4 are dependent upon rejected claim 1 and therefore carry the same deficiency.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-4, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Madray (4,688,358).

Regarding claim 1, Madray teaches a modular building unit (figure 1) comprising a shell (as illustrated in figure 1) formed from side wall lattice frameworks (as illustrated in figure 1, the four building walls are lattice frameworks) connected together by cross-beams at floor and ceiling height (joist 20 at floor height, headers 40 at ceiling height) and end wall lattice frameworks (as illustrated in figure 1) secured to

the ends of the resulting structure (as illustrated in figure 1, endwalls are secured to the sidewalls), wherein

each of the wall lattice frameworks (figure 1) comprises an array of mutually parallel spaced structural uprights (wall studs 12, 24) made from structural steel sections (column 14 lines 65-68 teaches steel construction), secured together by horizontal or diagonal cross-braces (V-braces 43 as illustrated in figure 1 are horizontal braces) also made from structural steel sections (column 14 lines 65-68 teaches steel construction),

each of the cross-beams (joists 20, headers 40) is made from a structural steel C-section (as illustrated in figure 1, 6, and 10, joists and headers are C-shaped) and is connected to the wall lattice frameworks by being sleeved into or around lateral spur members (adapter member as illustrated in figure 6 and 10) extending from the wall lattice frameworks prior to being welded thereto (column 3 lines 51-54 teaches the elements are welded to one another),

the cross-braces (V-braces 43) of each wall lattice framework are centred on a plane that is displaced outwardly from the internal dimensions of the shell (as illustrated in figures 1), and

internal cladding on the interior of the shell comprises wall panels (column 2 lines 36-38) and the structural portions of the wall are made of structural steel (column 14 lines 65-68 teaches steel construction).

However, Madray fails to explicitly disclose the interior wall panels are connected to the cross-braces by cold-formed steel resilient bars each of which has one

longitudinal edge portion secured to the cross-braces and an opposite longitudinal edge portion secured to the wall panels to hold the wall panels out of contact with the structural uprights and to define an extended heat path from the wall panels to the structural uprights through the resilient bars and through a longitudinally extending portion of each cross-brace.

Bowers teaches a modular housing structure wherein the interior wall panels are attached to resilient bars (horizontal chair rail 85) each of which has one longitudinal edge portion secured to the uprights (84) and an opposite longitudinal edge portion secured to the wall panels to hold the wall panels out of contact with the structural uprights (column 7 lines 43-45); as illustrated in figures 1 and 15, the horizontal chair rails are provided to attach the paneling to the wall system without attaching the panels to the studs) to define an extended heat path from the wall panels to the structural uprights through the resilient bars and through a longitudinally extending portion of each upright (the attachment of the panels to the horizontal chair rails would extend the heat path by pushing out the placement of the panels from the studs).

Therefore, from the teaching of Bowers, it would have been obvious to one of ordinary skill in the art at the time the invention was made to attach resilient bars to the cross braces of Madray in the way the resilient bars are attached to the studs as disclosed in Bowers in order to facilitate the application of the interior paneling to the wall system by creating a designated area for attachment of the panel to the wall.

Further Madray fails to explicitly disclose the steel sections are cold formed.

It would have been obvious to one of ordinary skill in the art to make the steel sections from a cold forming process since it has been held that "even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." (In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)).

Regarding claim 2, Madray teaches the structural uprights are of C-section (as illustrated in figures 1, 6, and 10, wall studs 12 and 24 are C-shaped) and the spur members (adapter members of figures 6 and 10) are T-shaped or L-shaped each comprising two limbs of which one sits inside the C-section of the associated structural upright and the other extends transversely therefrom as a spur to receive an end of an associated cross-beam (as illustrated in figure 6, the adapter member has 2 limbs, one which receives the uprights via web 62 and flange 64. The other limb receives the cross beams via web 72 and flanges 74, and 76).

Regarding claim 3, Madray teaches each limb of the spur member (adapter member as illustrated in figure 6 and 10) is made of structural steel and has a general C-section (as illustrated in figures 6 and 10, the limbs of the adapter member have a C-cross section; column 14 lines 65-68 teaches steel construction).

However, Madray fails to explicitly disclose the steel is cold rolled.

It would have been obvious to one of ordinary skill in the art to make the steel sections from a cold forming process since it has been held that "even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." (In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)).

Regarding claim 4, Madray teaches each C-section includes one or more swages in the back, side or front faces of the section (as illustrated in figures 6 and 10, the C-sections of the structural elements show swages via ribs 78 and 80 in the adapter member and the in-turned flanges in the uprights and cross beams).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

De Quesada (6,298,617) teaches a building system with cross braces and spur members engaging cross beams and uprights.

Fergen (3,498,014) teaches building uprights and crossbeams converging and cross braces.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON HOLLOWAY whose telephone number is (571) 270-5786. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on 571-272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JASON HOLLOWAY
Examiner
Art Unit 3633

JH

/Brian E. Glessner/
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